



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,091	01/24/2001	John Hsuan	13078.16US01	6403

23552 7590 10/04/2005

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

KL

Office Action Summary

Application No.

09/769,091

Applicant(s)

HSUAN ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11, 14 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 14 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is reference to response received 15 July 2005 to the office action mailed 14 March 2005. There are 14 claims, claims 1 – 7, 11, 14 and 26 – 30 pending for examination.

Response to Arguments

Applicant is arguing amended claims. Applicant's arguments with respect to claims 1 – 7, 11, 14 and 26 – 30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 12, 6 and 29 renders the claim unclear because:

claims 1 and 26 recites the limitation:

“examining a plurality of items of said resource provider to certify said resource provider's reliabilities”. Applicant has not clearly claimed how the applicant gets items of the resource provider which are used to certify the resource provider's reliabilities. In

Art Unit: 3629

addition, applicant has not clearly defined and claimed how the items are verified for certification prior to saving the record of the certified resource provide. In the disclosure associated with Fig. 3B applicant only recites to periodically check the resource providers recorded in the resource database.

“matching said resource provider according to said record of said resource provider with other certified resource provider having a record saved in said electronic hub system”. Applicant has not clearly claimed whether saving the record is adding the resource provider as certified resource providers, or, it is a search criteria for making the selection for a certified resource provider.

“collecting and analyzing said resource providers certified, and implementing matches and business plans for said resource providers certified according to similarities to business models of said resource providers certified to complete founding establishment of resources related to a company or a factory. Applicant has not clearly defined resource providers certified. Is it a record in a database, or, it is the certified resource provider. In addition, applicant has not clearly claimed “said resource providers certified”. It is not clear whether the said resource provider certified is the first resource provider who started the transaction or record related to that information about the resource provider who started the transaction, or, “said resource providers certified” is the registered certified resource provider, or, record related to the registered certified resource provider.

Art Unit: 3629

Claims 6 and 29, In the disclosure originally filed 24 January 2001, applicant recites "On the other hand, those possible business plans are defined their priorities according to similarities to the business models in the business model database" [0030].

Applicant recites the limitations:

defining a priority of said business plans according to similarities to said business models of said resource providers certified. Applicant has not clearly defined how priority of said business plan is defined, is it a sorted data, randomly selected data, round robin data. Also, applicant has not clearly defined whether the certified is a database, a record in a database, or, it is a certified resource provider.

sending said business plans to said resource providers certified; Applicant has not clearly defined whether the certified is a database, a record in a database, or, it is a certified resource provider.

displaying said business plans. Applicant has not clearly claimed where the business plan will be displayed.

Appropriate correction is required. Applicant must add the statement No New Matter Has Been Added.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 – 7, 11, 14 and 26 – 30 rejected under 35 U.S.C. 102(a) as being unpatentable by Eisenhart US Publication 2001/0047276.

Regarding claims 1 and 26, As best understood, Eisenhart teaches system and method for technology exchange and collaboration on a computer network, such as the Internet, facilitates collaboration between a technology Supplier and a Buyer of a technology asset or a Contributor to a technology project by providing a secure area to evaluate and develop the technology asset or project [0010]. Eisenhart teaches:

providing an electronic hub system capable of communicating with at least a resource provider [Fig. 3 and disclosure associated with Fig. 3];

communicating said resource provider with said electronic hub system [Fig. 1 and disclosure associated with Fig. 1];

examining a plurality of items of said resource provider to certify said resource provider's reliabilities [Fig. 7A and disclosure associated with Fig. 7A];

saving a record of said resource provider certified in said electronic hub system [Fig. 6, 7A and disclosure associated with Fig. 6, 7A];

matching said resource provider according to said record of said resource provider with other certified resource provider having a record saved in said electronic hub system [Fig. 7B and disclosure associated with Fig. 7B]

collecting and analyzing said resource providers certified, and implementing matches and business plans for said resource providers certified according to

Art Unit: 3629

similarities to business models of said resource providers certified to complete founding establishment of resources [Fig. 7B and disclosure associated with Fig. 7B] related to a company or a factory (field of use).

Regarding claims 2 and 27, Eisenhart teaches establishing an electronic contract of said resource provider.

Regarding claim 3, Eisenhart teaches electronic hub system comprises an electronic hub and a data storage device [Fig. 2, 3 and disclosure associated with Fig. 2, 3].

Regarding claim 4, Eisenhart teaches data storage device comprises a plurality of databases built therein (design choice) [Fig. 6 and disclosure associated with Fig. 6].

Regarding claims 5 and 28, Eisenhart teaches capability for databases to comprise:

- a resource database and said record of said resource provider saved therein;

- a certified resource database having said record of said resource provider certified with said items;

- a business model database having a plurality of business models of enterprises; and a plan database having at least a business plan combined said record of said resource provider with said business models of enterprises.

With respect to the recitation in claims 5 defining what type of database architecture will be used for the method and claim 28 defining what kind of data is being stored on the database, this is considered to be non-functional descriptive material that does not distinguish (define) over the applied prior art. Since the instant claims are article claims and the type of data claimed is considered to be non-functional descriptive material, the applied prior art satisfies the claim. The prior art stores data and is fully capable of storing the claimed type of data, this is the extent to which weight will be given to the claimed data. When descriptive material is not functionally related to the article, the descriptive material will not distinguish the invention from the prior art in terms of patentability, *In re Gulack*, 217 USPQ 401 (CAFC 1983).

Regarding claims 6 and 29, As best understood, Eisenhart teaches:

defining a priority of said business plans according to similarities to said business models of said resource providers certified (Using these criteria, screening and match-making component 440 can evaluate the quality of the match using a "scorecard" that details the relevancy of the match for each criteria) [0061];

saving said business plans in said electronic hub system [Fig. 7A and disclosure associated with Fig. 7A];

sending said business plans to said resource providers certified [Fig. 7D and disclosure associated with Fig. 7D]; and

displaying said business plans [claim 6].

Art Unit: 3629

Regarding claim 7, Eisenhart teaches resource provider comprises a capital provider (type of users is business choice) [0054].

Regarding claim 11, Eisenhart teaches items comprises an official document related to said resource provider (contents of data is design choice) [0054].

Regarding claims 14 and 30, applicant recites “the resource provider needs to select the suitable class and the suitable scope” [disclosure, 0028]. Eisenhart teaches:

logging in said electronic hub system [0012];

selecting a class for said resource provider [Registration Form, Fig. 7A and disclosure associated with Fig. 7A];

selecting a scope for said resource provider [Registration Form, Fig. 7A and disclosure associated with Fig. 7A];

assigning an identification number to said resource provider [Fig. 7A and disclosure associated with Fig. 7A]; and

saving said record of said resource provider in said electronic hub system [Fig. 7A and disclosure associated with Fig. 7A].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Eisenhart US Provisional Application 6,0192,600
2. McRedmond US Publication 2001/0034692
3. Thomas et al. US Patent 6,301,574

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Naresh Vig", with a stylized flourish at the end.

Naresh Vig
Examiner
Art Unit 3629

September 30, 2005